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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,549	06/29/2001	Clemens Auschra	A-21950/A/PC	4631

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,549

Applicant(s)

AUSCHRA ET AL

Examiner

Calli E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-15, and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 4/4/03.

The new grounds of rejection as set forth below are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-15, and 17-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to recite, "provided that thermosetting compositions are excluded". The cited phraseology clearly signifies a "negative" or "exclusionary" limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

The insertion of the phraseology as described above positively excludes thermosetting compositions, however, there is no support in the present specification for such exclusion. As support for the above amendment, applicants point to the last paragraph of page 16 of the present specification and note the disclosure of polymer solutions in the present invention. However, stating that the invention uses polymer solutions does not provide support for excluding thermosetting compositions. While the present specification may be silent with respect to thermosetting compositions, is noted that as stated in MPEP 2173.05(i), the "mere absence of a positive recitation is not the basis for an exclusion."

NOTE: If applicants were to remove the phrase "provided that thermosetting compositions are excluded" from claim 1 in response to the above rejection, it is noted that the rejections of record utilizing Barkac et al. (U.S. 6,391,391) and Barkac et al. (U.S. 6,268,433), as set forth in paragraphs 5 and 6 of the office action mailed 11/29/02, Paper No. 5, would be reinstated. Applicants argue that neither Barkac et al. '391 or Barkac et al. '433 are suitable references against the present claims given that the 35 USC 102(e) dates for each these references is after the effective filing date of the present application and thus, neither reference is available as prior art. However, it is noted that the 35 USC 102 dates for both Barkac et al. '391 and Barkac et al. '433 is 8/31/98 which is before the 12/31/98 effective filing date of the present application and thus, the references are proper prior art against the present claims.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites a method which comprises incorporating "a the pigment dispersion according to claim 1 therein". The scope of the claim is confusing given that the phrase appears to contain extra words; it is advised that either "a" or "the" is deleted. Further, the scope of the claim is confusing because claim 1 is drawn to a composition, not a pigment dispersion.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 3-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyjaszewski et al. (U.S. 5,807,937) in view of either Pearlstine et al. (U.S. 6,087,416) or Kappel et al. (U.S. 6,063,834).

The rejection is adequately set forth in paragraph 10 of the office action mailed 11/29/02, Paper No. 5, and is incorporated here by reference.

8. Claims 1, 3-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearlstine et al. (U.S. 6,087,416) or Kappele et al. (U.S. 6,063,834) either of which in view of Matyjaszewski et al. (U.S. 5,807,937).

The rejection is adequately set forth in paragraph 11 of the office action mailed 11/29/02, Paper No. 5, and is incorporated here by reference.

With respect to newly added claim 19, it is noted that both Pearlstine et al. and Kappele et al. disclose method of preparing ink which comprises incorporating pigment and block copolymer dispersant into the ink (Pearlstine et al. – col.3, lines 5 and 50-52 and Kappele et al. – col.6, lines 56-58 and col.7, lines 54-64).

Response to Arguments

9. Applicants' arguments filed 4/4/03 have been fully considered but they are not persuasive.

Specifically, applicants argue that:

(a) there is no disclosure in Matyjaszewski et al. of pigment as required in the present claims.

(b) There is no disclosure in Matyjaszewski et al. that the A and B blocks (referred to as M¹ and M² by Matyjaszewski et al.) present in the block copolymer differ in polarity wherein the difference is obtained by copolymerizing blocks A and B with difference amounts of functional monomers as required in the present claims.

With respect to argument (a), applicants note, and examiner agrees, that while Matyjaszewski et al. disclose the use of atom transfer radical polymerization (ATRP) block copolymer in inks, there is no explicit disclosure of pigment as required in the present claims.

However, this is why Matyjaszewski et al. is used in combination with either Pearlstine et al. or Kappel et al. which each disclose ingredients including pigment typically found in ink compositions. While it is agreed that Pearlstine et al. or Kappel et al. disclose that the ink can contain either dye or pigment, absent clear and convincing evidence to the contrary regarding the use of pigment as opposed to dye, it would have been within the skill level of one of ordinary skill in the art to choose to use pigment in the ink of Matyjaszewski et al.

Applicants argue that there is no motivation to combine Matyjaszewski et al. with Pearlstine et al. or Kappel et al. other than hindsight given that Pearlstine et al. or Kappel et al. are each drawn to inks comprising conventional polymers known in the art not polymers produced from ATRP.

However, on the one hand, given that Matyjaszewski et al. broadly disclose the use of polymer produced by ATRP in inks, it would have been obvious to one of ordinary skill in the art that such inks would necessarily contain ingredients conventionally found in inks including pigment, carrier, and additives disclosed by either Pearlstine et al. or Kappel et al. Thus, it is the examiner's position that there is motivation to combine Matyjaszewski et al. with either Pearlstine et al. or Kappel et al.

On the other hand, given that either Pearlstine et al. or Kappel et al. is drawn to inks which utilize block copolymer dispersants and given that Matyjaszewski et al. disclose the use of use of block copolymers which function as dispersants (col.25, line 2) and are suitable for use in

inks, it is the examiner's position that there is motivation to combine either Pearlstine et al. or Kappele et al. with Matyjaszewski et al.

With respect to argument (b), it is noted that col.16, lines 46-49 of Matyjaszewski et al. disclose that the block copolymer is prepared from monomers which can each be (meth)acrylic acid, (meth)acrylate, acrylonitrile, etc. Thus, the two blocks obtained from these monomers will clearly possess different amounts of functional groups given that one monomer contains little if any functional groups, i.e. (meth)acrylate, while the other monomer necessarily possesses certain amount of functional groups, i.e. (meth)acrylic acid. In light of this disclosure, and given that col.24, lines 66-67 of Matyjaszewski et al. discloses block copolymers in which the blocks alternate between polar and non-polar monomers and col.27, lines 6-9 discloses that monomers in adjacent blocks are not identical, it is the examiner's position that the block copolymer of Matyjaszewski et al. meets the limitations regarding block copolymer possessing blocks which differ in polarity obtained by copolymerizing polymer blocks with different amounts of functional monomers as presently claimed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
June 24, 2003